

REMARKS

New claims 32-41 are identical to claims 1-5, 7, 9, 10, 12, and 13, respectively, of U.S. Patent No. 6,511,847 ("the '847 patent"), titled "Recombinant p53 Adenovirus Methods and Compositions," which was issued on January 28, 2003. Applicants hereby copy these claims in order to preserve rights under 35 U.S.C. §135(b).

Support for the new claims can be found throughout the present application. Specifically, support for claims 32 and 35 is found, *e.g.*, in Figure 4 and on page 33, lines 4-14; support for claim 33 is found, *e.g.*, on page 33, lines 18-19; support for claim 34 is found, *e.g.*, on page 33, lines 14-18; support for claim 36 is found, *e.g.*, on page 33, lines 10-11; support for claims 37, 40, and 41 is found, *e.g.*, in Example II beginning on page 32; and support for claims 38 and 39 is found, *e.g.*, in Figure 4. Thus, no new matter is introduced by the instant preliminary amendment.

Applicants do not believe any of the remaining claims of the '847 Patent represent a patentably distinct invention over claims 1-5, 7, 12, and 13 of that patent. Claims 6 and 11 depend from claim 1 and recite specific portions of the adenoviral genome: map units 0-16, 0-100, and 1.3-9.2. Map units 0-100 represent the entire genome, and map units 1.3-9.2 represent E1 region (see description in the '847 Patent, column 17, lines 1 and 10-11). Since the adenoviral genome was known in the art and the deletion of E1 region in producing recombinant adenovirus was known, identification of the E1 region using the specific map units does not provide separate patentability. Claim 8, depending from claims 1 and 2, recites the use of an SV40 polyadenylation signal, which was also known in the art and cannot provide separate patentability for the claims.

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Amdt. dated January 27, 2004
Preliminary Amendment

PATENT

If a telephone conference would expedite prosecution of this application, the
Examiner is invited to telephone the undersigned at 415-576-0200.

Respectfully submitted,



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